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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,830	03/15/2001	Nobuyoshi Morimoto	44471-255154 (13700)	5613
23370	7590	04/27/2005	EXAMINER	
JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309			RHODE JR, ROBERT E	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 04/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/808,830

Applicant(s)

MORIMOTO, NOBUYOSHI

Examiner

Rob Rhode

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant amendment of 3-1-05 amended the specification and claims 1, 5, 9, 13 -15 and 18 as well as traversed rejections of Claims 1 - 18.

Currently, claims 1- 18 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 - 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernard (US 5,918,213) in view of Rose (US 5,708,709).**

Regarding claim 1 and related claims 1, 5, 9 and 18, Bernard teaches a digital distribution method for transmitting digital contents representing an entity of a product over a network and, subsequently, delivering the product, said digital distribution method comprising the steps of: providing, by a product vendor, a plurality of products for browsing over the network (see at least Abstract, Col 3, lines 55 – 62 and Figure 6); selecting, by a product buyer, a desired product from a plurality of browsed items, specifying a shipping charge for a delivery of the product item, and placing an order for

Art Unit: 3625

the product over the network (see at least Col 43, lines 32 – 47 and Col 45, line 35); and delivering the product from the vendor to the buyer when a required delivery period has elapsed from a time the order is placed, said required delivery period being determined based on said shipping charge (Col 43, lines 39 - 54). Please note, Bernard does not specifically disclose determining required delivery time based on shipping charge. However, Bernard does disclose delivery and associated shipping rules. In that regard, it is old and well known that shipping of a product to customer can be accelerated based on the amount the customer is willing to pay. For example, the customer chooses overnight delivery and as result the cost will be greater to them but the time to receive/deliver the product is reduced. Thereby, it would have been obvious to one of ordinary skill to have extended the method and system of Bernard with a shipping rule required delivery period has elapsed from a time the order is placed, said required delivery period being determined based on said shipping charge. Thereby, the vendor will have an exact date for the arrival of the product to the customers address.

However, Bernard does not specifically disclose and teach a method of incorporating, by the vendor, the digital contents into a control program controlling the digital contents and transmitting the control program to the buyer over the network in response to the order, said digital contents representing the entity of the product item selected by the buyer; and disabling, by said control program, the digital contents when a contents availability period has elapsed, said contents availability period being set in said control program and set to a time longer than the required delivery period.

On the other hand, Rose in the same area of online ordering of digital content/products teaches a method of incorporating, by the vendor, the digital contents into a control program controlling the digital contents and transmitting the control program to the buyer over the network in response to the order, said digital contents representing the entity of the product item selected by the buyer (see at least Abstract and Col 1, lines 20- 29 and lines 61 – 63); and disabling, by said control program, the digital contents when a contents availability period has elapsed, said contents availability period being set in said control program and set to a time longer than the required delivery period (Col 1, lines 21 - 29). Please note that Rose does not specifically disclose a delivery date. However, Bernard does disclose delivery and associated shipping rules. In that regard, it is old and well known that shipping of a product to customer can be accelerated based on the amount the customer is willing to pay. For example, the customer chooses overnight delivery and as result the cost will be greater to them but the time to receive/deliver the product is reduced. Moreover, Rose does disclose expiration at a certain date, which can obviously be set by the delivery time as taught by Bernard. In that regard, it would have been obvious to one of ordinary skill to have extended the method of Rose with a delivery date. In this manner, the customer will not be able to use the digital content after a certain date, which is set to start at the delivery date.

Art Unit: 3625

It would have been obvious to one of ordinary skill in the art to have provided the method and system of Bernard with the method and system of Rose to have enabled a method of digital distribution method for transmitting digital contents representing an entity of a product over a network and, subsequently, delivering the product, said digital distribution method comprising the steps of: providing, by a product vendor, a plurality of product items for browsing over the network; selecting, by a product buyer, a desired item from a plurality of browsed items, specifying a shipping charge for a delivery of the product item, and placing an order for the product over the network; incorporating, by the vendor, the digital contents into a control program controlling the digital contents and transmitting the control program to the buyer over the network in response to the order, said digital contents representing the entity of the product item selected by the buyer; delivering the product from the vendor to the buyer when a required delivery period has elapsed from a time the order is placed, said required delivery period being determined based on said shipping charge; and disabling, by said control program, the digital contents when a contents availability period has elapsed, said contents availability period being set in said control program and set to a time longer than the required delivery period – in order to provide online ordering and control by the vendor of digital content as well as physical delivery of the digital content. Bernard discloses a digital distribution method for transmitting digital contents representing an entity of a product over a network and, subsequently, delivering the product, said digital distribution method comprising the steps of: providing, by a product vendor, a plurality of product items for browsing over the network; selecting, by a product buyer, a desired

Art Unit: 3625

item from a plurality of browsed items, specifying a shipping charge for a delivery of the product item, and placing an order for the product over the network; and delivering the product from the vendor to the buyer when a required delivery period has elapsed from a time the order is placed, said required delivery period being determined based on said shipping charge (Abstract, Col 3, lines 55 – 62 and Figure 6). Rose discloses in the same area of online ordering of digital content a method of incorporating, by the vendor, the digital contents into a control program controlling the digital contents and transmitting the control program to the buyer over the network in response to the order, said digital contents representing the entity of the product item selected by the buyer; and disabling, by said control program, the digital contents when a contents availability period has elapsed, said contents availability period being set in said control program and set to a time longer than the required delivery period (Col 1, lines 21 - 29).

Therefore, one of ordinary skill in the art would have been motivated to extend the method and system of Bernard with a method and system that incorporates, by the vendor, the digital contents into a control program controlling the digital contents and transmitting the control program to the buyer over the network in response to the order, said digital contents representing the entity of the product item selected by the buyer; and disabling, by said control program, the digital contents when a contents availability period has elapsed, said contents availability period being set in said control program and set to a time longer than the required delivery period. Thereby, the vendor has a method for limiting revenue loss due to extended and unauthorized use of previously distributed digital content.

Regarding claim 2 and related claims 6, 10 and 16, Rose teaches a digital distribution method wherein said control program is transmitted with the digital contents incorporated in such a way that only the control program may process the digital contents and, when the transmission of said control program is completed, starts a time measuring operation of the contents availability period (Col 1, lines 20 – 29).

Regarding claim 3 and related claims 3, 7, 11 and 17, Rose teaches a digital distribution method wherein, when the contents availability period expires, said control program erases the digital contents or erases itself in conjunction with the digital contents (Col 1, lines 20 – 27). Please note that Rose does not specifically disclose erasing. However, Rose does disclose disabling the program. In that regard, it would have been obvious to one of ordinary skill in the art to have extended the method of Rose to include erasing the program. Thereby the digital contents are removed from the client's storage, which will increase the storage space for them as well as enhance the vendor's protection of losing revenue as well as ensuring enforcement of any distribution terms and conditions.

Regarding claim 4 and related claims 8 and 12, Bernard teaches a digital distribution method wherein the product includes various books and documents, music CDs, and video DVDs (Abstract).



Regarding system claims 13, 14 and 15, the reference sections of Bernard and Rose teach the limitations of these claims with the addition of Bernard Figures 5 - 6, 26 and 40 as well as Rose Figure 1 – 2 and 9B.

### ***Response to Arguments***

Applicant's arguments filed 3-1-05 have been fully considered but they are not persuasive.

Applicant argues that Bernard does not describe transmitting a control program over the network for a digital product/content.

Bernard as noted above was not the reference that disclosed a control program for digital content. Rather, Rose disclosed and taught these limitations.

Applicant argues that neither Bernard nor Rose discloses or suggests incorporating digital contents “representing an entity of an ordered product into a control program controlling the digital contents and transmitting the control program over the network”.

First, the claim languages as recited is very broad and vague and thereby open to a broad interpretation for examination purposes. In that regard, the apparent novelty of the invention is the ability for a vendor to incorporate a control program into a digital content product ordered online. With this interpretation, Rose would have suggest and fairly taught one of ordinary skill that a vendor of digital products has the well known

Art Unit: 3625

capability to incorporate a control program into a digital content product ordered online, which will limit the time that the product/entity can be used (see at least Col 1, lines 22 – 31 and lines 59 – 60 as well as Col 2, lines 3 – 9).

Applicant argues that amended claim one would not have been obvious to one of ordinary skill at the time of the invention.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Bernard and Rose are in the same area of online ordering and delivery of digital content. Moreover, the references both teach limiting the time that a customer has to the use/time of online content (see Bernard Col 46, lines 36 - 46 and Rose Col 1, lines 20 – 31). Thereby, one of ordinary skill in the art would have been motivated to extend the method and system of Bernard with a method and system that incorporates, by the vendor, the digital contents into a control program controlling the digital contents and transmitting the control program to the buyer over the network in response to the order, said digital contents representing the entity of the product item selected by the buyer; and disabling, by said control program, the digital contents when a contents availability

Art Unit: 3625

period has elapsed, said contents availability period being set in said control program and set to a time longer than the required delivery period. In this manner, the vendor has a method for limiting revenue loss due to extended use and unauthorized use of the digital content.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

**IMPORTANT** – After April 14, 2005, the telephone numbers for Wynn Coggins and Rob Rhode will change to 571.272.7159 and 571.272.6761 respectively.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

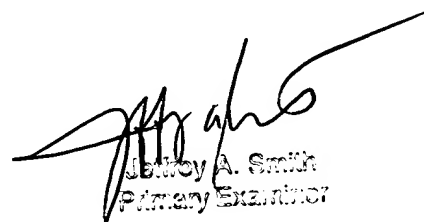
**Alexandria, Va. 22313-1450**

or faxed to:

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**(703) 746-7418** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

RER



Jeffrey A. Smith  
Primary Examiner